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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,923	08/27/2003	Anthony Dezonno	6065-86942	4105

24628 7590 09/27/2007
WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

HA, DAC V

ART UNIT	PAPER NUMBER
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2611

MAIL DATE	DELIVERY MODE
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09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,923

Applicant(s)

DEZONNO, ANTHONY

Examiner

Dac V. Ha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed on 07/20/07.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al (US 5,557,658) (hereafter Gregorek) in view of He (US 5,642,407).

Regarding claim 1, Gregorek discloses all claimed subject matter “suppressing at least one audio tone notifying a user of a first communications device that a connection is being established; and substituting information unrelated to the at least one suppressed audio tone to the user of the first communications device while the connection is being established in Abstract; col. 2, line 62 to col. 3, line 12.

Gregorek differs from the claimed invention in that it doesn’t teach the claimed subject matter “wherein the information is automatically configured based upon a

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profiled the user generated by monitoring the user's use of the first communication device". However, in the same field of endeavor, He teaches such claimed subject matter in col. 1, lines 51-59; col. 3, lines 26-56; col. 4, line 46 to col. 8, line 12.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the teaching of automatically presenting advertisement to caller according to caller's "profile" into Gregorek to further optimize the efficiency of the advertisement.

Regarding claims 17, 18, 34, see claim 1.

Regarding claim 35, Gregorek discloses "a tone generator to send dial tones to a user of a communications device which upon demand also sends dial tones" (col. 7, lines 9-10"; "memory for storing information" (Fig. 2, element 102); and "a communicator which presents the stored information to the user while the connection is being established" (Fig. 1, element 1, 23; col. 2, element 16; col. 9, line 45 to col. 10, line 15). Further, even though Gregorek doesn't show "a speaker", however, "a speaker" is inherent for a telephone. Gregorek also discloses "a display" in col. 6, line 65.

Regarding claims 2, 3, 19, 20, 36, 37, Gregorek further discloses "the information includes advertisements, music, movie clips, news headlines, sports scores, stock quotes, weather, time of day, calendar reminders, horoscopes, messages, and inspirational sayings" in col. 12, lines 17-27.

Regarding claims 5, 22, 39, see combination of claim 1 and 35 above.

Regarding claims 4, 6-16, 21, 23-33, 38, 40-50, these claimed subject matter would have been obvious to one skilled in the art as design specific/preference based on the disclosure of Gregorek (see Gregorek,whole document).

Terminal Disclaimer

5. The terminal disclaimer filed on 07/20/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of commonly owed US Patent No. 6,810,077 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dac V. Ha whose telephone number is 571-272-3040. The examiner can normally be reached on 4/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Payne can be reached on 571-272-3024. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Dac V. Ha', with a horizontal line underneath.

Dac V. Ha
Primary Examiner
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